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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,515	12/31/2003	Minco Yamakawa	042390.P15614	9237
7278	7590	11/01/2007		
DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			EXAMINER MARTINELL, JAMES	
			ART UNIT 1634	PAPER NUMBER
			MAIL DATE 11/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/750,515

Applicant(s)

YAMAKAWA ET AL.

Examiner

James Martinell

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/9/07 & 7/23/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-19 is/are allowed.
- 6) ☒ Claim(s) 20-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: EAST Search History.

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The amendment filed November 13, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment to paragraph 101 contains New Matter. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed February 9, 2007, page 2). Applicants' arguments (response filed May 9, 2007, page 9) are most unconvincing. Applicants assert that, "A search of the USPTO database shows that there is *only one* application filed December 29, 2003, entitled "Composite Organic-Inorganic Nanoparticles." Applicants do not identify just what is meant by "the USPTO database" or do they report what type of search was done (*i.e.*, fields or search query) or the actual results of the search. A search of the Pre-Grant Publications reveals that there is no applications filed December 29, 2003 with the title "Composite Organic-Inorganic Nanoparticles." See the EAST search results "10750515-nano.wsp" in this file. Serial No. 10/748,336 (U.S. Patent Application Publication 2005/0147963, Su et al) has a title of "Composite Organic-Inorganic Nanoparticles and Methods for Use Thereof" and thus does not correspond to the application title referred to in the specification as filed at paragraph 0111. Applicant is required to cancel the new matter in the reply to this Office Action.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, *e.g.*, *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 20-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 5, 10-15, 17, 18, 28, and 30-32 of copending Application No. 10/251,152. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious for one of ordinary skill in the art to possess the compositions of claims 20-28 of the instant application in view of the methods of using compositions that embrace the compositions of claims 20-28 of the instant application as outlined in claims 1, 4, 5, 10-15, 17, 18, 28, and 30-32 of copending Application No. 10/251,152. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed February 9, 2007, page4). It is noted that applicants have not argued the merits of this rejection in the response filed May 29, 2007 or in the response filed July 23, 2007. This is not an invitation to submit affidavit, documentary, or other evidence or argumentation subsequent to a final Office action.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 20-32 and 35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 11/077,577. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious for one of ordinary skill in the art to possess the compositions and systems of claims 20-32 and 35 of the instant application in view of the methods of using compositions that embrace the compositions of claims 20-32 and 35 of the instant application as outlined in claims 1-18 of copending Application No. 11/077,577. In addition, the compositions and systems of claims 19-27 of Serial No. 11/077,577 embrace claims 20-32 and 35 of the instant application. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed February 9, 2007, page6). It is noted that applicants have not argued the merits of this rejection in the response filed May 29, 2007 or in the response filed July 23, 2007. This is not an invitation to submit affidavit, documentary, or other evidence or argumentation subsequent to a final Office action.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 20-36 are rejected under 35 U.S.C. 102(e) as being anticipated by either one of Chan et al (U.S. Patent Application Publication 2004/0058328) or Chan et al (U.S. Patent Application Publication 2004/0126820). This rejection is repeated for reasons already of record (*e.g.*, Office action mailed February 9, 2007, page 6). Each of the references discloses compositions and systems that are embraced by the claims (*e.g.*, see '328 in the Abstract, paragraphs 0001, 0019, 0020, 0055, and 0078-0087, and claims 19-27 and '820 in the Abstract, paragraphs 0030-0039, 0057, 0077, 0093-0113, and 0154-0160, and claims 25-28).

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 20-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Chan et al (U.S. Patent Application Publication 2005/0208554). This rejection is repeated for reasons already of record (*e.g.*, Office action mailed February 9, 2007, page 7). The reference discloses compositions and systems that are embraced by the claims (*e.g.*, see '328 in the Abstract, paragraphs 0019, 0020, 0047-0072, 0081-0086, 0093-0096, 0101, and 0102, and claims 19-30). The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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Claims 20-24 and 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Han et al (Nature Biotechnology 19: 631 (2001)). This rejection is repeated for reasons already of record (*e.g.*, Office action mailed December 23, 2005, page 7, first full paragraph and Office action mailed February 9, 2007, page 7). Applicants' arguments (response filed May 9, 2007, pages 10-11) are not convincing because the property of providing a quality control check can be any part of the probe of Han et al. The function here is determined by what one does with a particular sequence. Thus, function is equivalent to an intended use.

Claims 20-23, 26, 28-32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirkin et al (U.S. Patent No. 6,361,944) in view of Nygren et al (U.S. Patent No. 6,060,237). This rejection is repeated for reasons already of record (*e.g.*, Office action mailed February 9, 2007, page 7). Applicants' assertions (response filed May 9, 2007, page 11) are not convincing because the property of providing a quality control check can be any part of the probe of Mirkin et al. The function here is determined by what one does with a particular sequence. Thus, function is equivalent to an intended use.

Claims 1-19 are allowable over the prior art of record.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719.

The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735.


OFFICIAL FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any Official Communication to the USPTO should be faxed to this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.


James Martinell, Ph.D.
Primary Examiner
Art Unit 1634

10/23/07

EAST Search History

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	1514	nanoparticles[ti]	US-PGPUB; USPAT	OR	ON	2007/10/22 11:50
L2	0	@ap="20031229"	US-PGPUB; USPAT	OR	ON	2007/10/22 11:50
L3	1909	@ad="20031229"	US-PGPUB; USPAT	OR	ON	2007/10/22 11:50
L4	3	l1 and l3	US-PGPUB; USPAT	OR	ON	2007/10/22 11:50

10/22/07